

## **REMARKS**

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Lefebvre.

In figures 1-4, Lee discloses a pop-up dispenser (10) for dispensing sheets of aluminum foil, as described in column 1, lines 44-48. Each sheet has a lead portion and a trailing portion. The lead portion of the first sheet (30) of aluminum foil extends through a dispensing orifice (elongated opening 14) to an elevation above that of the dispensing unit (10), as shown in figure 3. The trailing portion of the first foil (30) overlaps the lead portion of the next hair foil to be dispensed, as discussed in column 1, lines 10-19 and column 2, lines 48-51.

Withdrawing the first sheet of foil (30) pulls the next sheet, as discussed in column 1, lines 19-23. The withdrawing of the first sheet of foil (30) can be achieved with one hand. The first foil sheet (30) can be applied to a person's hair immediately after being dispensed without any further preparation if the foil sheet is already the proper size for applying to hair. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the foil sheets dispensed by the dispenser of Lee 3.5 to 6 inches wide, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ (CCPA 1955).

Lee does not disclose the application of foil to a person's hair. Lefebvre discloses the application of foil to a person's hair as prior art in column 1, lines 11-40. It would have been obvious to one having ordinary skill in the art at the time the invention was

made to apply the foil of Lee to a person's hair, as taught by Lefebvre, in order to highlight only selected strands of hair.

Note: According to MPEP 2111.02, the applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of the applicant's invention if the applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of."

The declaration under 37 CFR 1.132 filed 7 November 2005 is insufficient to overcome the rejection of claims based upon commercial success as set forth in the last Office action because: A nexus between the claimed invention and the alleged success has not been established. MPEP 716.03(b) IV states, "Gross sales figures do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985), or as to the time period during which the product was sold, or as to what sales would normally be expected in the market. *Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988)." Here, the declaration only gives the number of boxes sold annually for the past 4 years. The declaration does not show this product's place in the market, that the product's profitability is linked to the claimed invention, or that the profitability per unit is anything out of the ordinary in the industry involve. A nexus between the claimed invention and the alleged success has not been established.

Applicant submits a Second Declaration to address the concerns above stated by the Examiner.

Product Club began selling the pop-up foil described in the above patent application in the fourth quarter of 2001. Prior to this time, Product Club had been selling roll foil and pre-cut foil to the Beauty Industry. Roll foil is defined as foil that is on a roll that can be cut when needed and used for hair coloring applications. Pre-cut foil is defined as foil that is stacked, one sheet on top of another, much like a deck of playing cards, which can then be used for haircoloring applications. (Declaration, para. 2).

The differences between the roll foil, pre-cut foil and pop-up foil all relate to the method in which they are dispensed, and then applied to the hair, which is directly related to the claimed invention. (Declaration, para. 3).

The claims of the present invention which relate to the pop-up foil relate to removing a first sheet of hair foil from the pop-up dispenser, the first sheet of hair foil ranging in width from 3.5-6". The sheet of hair foil has a lead portion and a trail portion. The lead portion of the sheet of hair foil extends through a dispensing orifice through an elevation above the dispensing unit. The trailing portion of the first hair foil sheet overlaps with a lead portion of the next hair foil sheet to be dispensed. By withdrawing the first sheet of hair foil, the next hair foil sheet is pulled through the orifice of the dispenser, and is awaiting further use. The first hair foil sheet can then be applied directly to a person's hair. (Declaration, para. 4).

With the roll foil, the foil must be cut to the appropriate length and then placed into a person's hair for haircoloring applications. This process requires multiple steps that are not required with the pop-up foil method. (Declaration, para. 5).

With the pre-cut foil, the first sheet, and each subsequent sheet of foil, must be separated from the stack of foil before being applied to a person's hair. Therefore, the second sheet, and each subsequent sheet, is not ready for use. This process requires multiple steps that are not required with the pop-up foil method. (Declaration, para. 6).

Therefore, the method described in paragraph 4 above for Product Club's pop-up foil creates a convenient and time saving way of dispensing hair foil which has led to Product Club's success. (Declaration, para. 7).

From 2001 until today, the market share for Product Club's pop-up foil has gone from 0% in 2001 to almost 60% in 2005 of the foil being sold by Product Club to the Beauty Industry. Product Club's pop-up foil sales have almost tripled in size since 2002. The other foil products such as roll foil and pre-cut foil have not grown to the same extent. (Declaration, para. 8).

Since the only difference in the pre-cut foil, the roll foil and the pop-up foil is the method in which they are dispensed and placed in the hair, Product Club's pop-up foil market share and profitability must be directly linked to the method in which the pop-up foil is being dispensed and placed in the hair. (Declaration, para. 9).

Therefore, Claims 9 and 10 are not obvious over the above prior art.

Applicant believes that the application is now in condition for allowance.

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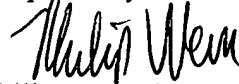
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Respectfully submitted,



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